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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/866,960 | 05/29/2001 | Neil D. Scancarella | Rev 01-6 | 7403 |

26807 7590 02/12/2007

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| EXAMINER |
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KIM, VICKIE Y

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1618

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 3 MONTHS | 02/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/866,960

Applicant(s)

SCANCARELLA ET AL

Examiner

Vickie Kim

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been fully considered and are partially persuasive. However, because of the applicant's argument emphasizes organic pigment, upon further consideration, a new ground(s) of rejection is made in view of Patil et al (US6342209). Therefore, the rejection has been withdrawn.

Status of Application

2. Claims 1-20 are pending and presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patil et al (US6342209).

The claims are drawn to water and oil emulsion (e.g. water in oil emulsion or oil in water emulsion) which comprises silicone resin film forming polymer; at least one film forming polymer selected from the group consisting of (i) a silicone/acrylate copolymer, (ii) a vinyl/silicone copolymer or a mixture thereof; at least one organic pigment; at least one linear volatile silicone oil present about 0.1-99.9%; and water present about 0.1-95%.

Art Unit: 1618

Patil et al teaches a cosmetic composition such as a mascara product is made into the form of water-in-oil or oil-in-water emulsion, wherein the mascara contains 0.1-50% water, 0.5-55% oil, 0.1-30% pigment and 0.1-30% of one or more synthetic polymers(e.g. film forming polymers) see col. 12, lines 37-44. In light of Patil's teaching in his disclosure, film forming polymers(synthetic polymers) wherein the polymers are one or more film forming polymers(0.1-95%) selected from silicone resins(e.g. trimethylsiloxo silicate), silicone/acrylate copolymers and so on, see col. 2, lines 62-col. 3, lines 41. US'209 al teaches organic pigments present about 0.1-30%, see col. 8, lines 10-29. Furthermore, US'209 teaches silicone oils including volatile cyclic silicone oils(e.g. cyclomethicone see present about 0.5-95%, see col. 6, lines 50-67), and an oil phase comprising dimethicone and isohexadecane or isododecane, (see col.7, lines 26-43); and 0.1-50% water.

As to claims 4-13, all the critical elements required by the instant claims are well taught at col. 8, lines 9-29. For example, US'209 teaches azo, triphenylmethane, anthraquinone, xanthene dyes which are designated as D&C and FD&C blues, browns, greens, oranges, reds, yellows, etc dyes.

It is noted that the recitation found in preamble of claim 7 has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is note that claim 15 which requires

Art Unit: 1618

Dimethicone's viscosity of 1 centipoise at, is met by the cited reference because Patil teaches a dimethicone and 1 centipoise at 20°C is inherent property and thus the claim is met.

Thus, one skilled artisan readily envisaged the claimed invention from Patil's teaching.

Even if the claimed composition has not been duplicated in any examples exemplified composition and minor variations in order to maximize industrial applicability as well as customer satisfaction is modified in routine practice. As to claims 9 and 14, for example, claim 9 requires monoazo whereas US'209 teaches azo; claim 14 requires pyrazole as yellow pigment whereas US'209 teaches other yellow pigments, said modification are already well known in the art at that time of the invention was filed and does not render the claims patentable (see evidentiary documents, PTO-892, US6458390, 6326013, 6091491). Therefore, even if applicant argues that Patil's reference is not anticipating the claimed invention because it has not been as identical, the claimed invention is readily apparent and considered to be obvious over the teaching of Patil's patent and prior art of the record.

Each critical element required by the instant claims is taught by cited reference and minor variations such as selection of active agents and carriers including the selection of its derivatives and analogs(functionally equivalent species), mixing and adjusting process in order to determine most effective outcome(results) is considered to be well within the skilled level of the artisan.

One would have been motivated to do so, with reasonable expectation of success because it is always desirable to have extended therapeutic modalities to improve patient's compliance by enhancing patient satisfaction and increasing the selection option. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan and thus, obvious, absent evidence to the contrary. Thus, the claimed subject

Art Unit: 1618

matter is well within the scope of the patented invention which renders the claims not patentably distinct over the prior art of the record.

All the critical elements are well taught by the cited reference and the claimed invention is properly included in this rejection.

Conclusion

1. No claim is allowed. This is 2nd non-final rejection.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Hartley reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VICKIE KIM
PRIMARY EXAMINER
Vickie Kim
Primary Patent Examiner
Art Unit 1618

